

REMARKS

Claims 1 through 13 and 16 through 20 are currently pending in the application.

Claims 14 and 15 have been cancelled.

Claims 1, 5, 8, 13, 18, and 19 have been amended herein.

This amendment is in response to the Office Action of June 6, 2005.

35 U.S.C. § 102(e) Anticipation Rejections

Anticipation Rejection Based on Choksi et al. (U.S. Patent 6,477,243)

Claims 1 through 20 were rejected under 35 U.S.C. § 102(e) as being anticipated by Choksi et al. (U.S. Patent 6,477,243) ("Choksi"). Applicant respectfully traverses this rejection

Applicant asserts that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

Verdegaal Brothers v. Union Oil Co. of California, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

After carefully considering the cited prior art, the rejections, and the Examiner's comments, Applicant has amended the claimed invention to clearly distinguish over the cited prior art.

Regarding currently amended independent claim 1, such claim is directed to "[a] method of distributing a facsimile to an Internet enabled device, comprising . . . receiving a facsimile; storing said facsimile on a storage media at a specific location; identifying an Internet enabled device associated with each intended recipient of said facsimile; and notifying each identified Internet enabled device of said specific location for said saved facsimile."

Applicant asserts that the amendments to independent claim 1 are merely editorial in nature and not for distinguishing the claimed invention from the cited prior art.

Applicant asserts that Choksi does not expressly or inherently identically describe each and every element of currently amended independent claim 1 in as complete detail as contained in the claim to anticipate the claimed invention under 35 U.S.C. § 102. Applicant asserts that Choksi does not identically describe the element of the claimed invention of currently amended

independent claim 1 calling for “notifying each identified Internet enabled device of said specific location for said saved facsimile.” Applicant asserts that a few examples of Internet enabled devices are e-mail enabled printers, embedded web server printers, e-mail enabled print servers, and web browser enabled printers. There is no description anywhere in Choksi of an element of the claimed invention of currently amended independent claim 1 calling for “identified Internet enabled device.” Therefore, Choksi does not anticipate independent claim 1 under 35 U.S.C. § 102. Accordingly, currently amended independent claim 1 is allowable.

Claims 2 through 4 are allowable as depending from allowable currently amended independent claim 1.

Regarding currently amended independent claim 5, such claim 5 is directed to “[a] method of distributing a facsimile, comprising . . . sending a facsimile to a registered address; retrieving said facsimile; determining a set of intended recipients for said facsimile from said registered address; saving said facsimile to a specific storage location on a storage media; and notifying each of said set of intended recipients via an Internet enabled device or via facsimile of said saved facsimile and said specific storage location for retrieving said facsimile.”

Applicant asserts that Choksi does not expressly or inherently identically describe each and every element of currently amended independent claim 5 in as complete detail as contained in the claim to anticipate the claimed invention under 35 U.S.C. § 102. Applicant asserts that Choksi does not identically describe the element of the claimed invention of currently amended independent claim 5 calling for “notifying each of said set of intended recipients via an Internet enabled device or via facsimile of said saved facsimile and said specific storage location for retrieving said facsimile.” Applicant asserts that a few examples of Internet enabled devices” are e-mail enabled printers, embedded web server printers, e-mail enabled print servers, and web browser enabled printers. Applicant asserts that there is no description anywhere in Choksi for the element of the claimed invention calling for an “Internet enabled device.” Therefore, Choksi cannot describe that element. Regarding the element of the claimed invention calling for “via facsimile,” Choksi describes sending a confirmation message to the facsimile machine of a sender. Column 7, lines 18-36. However, Applicant asserts that Choksi cannot describe the element of the claimed invention of currently amended independent claim 5 calling for “notifying

each of said set of intended recipients . . . via facsimile of said saved facsimile.” Therefore, Choksi does not describe that element. Applicant asserts that Choksi does not describe the element of the claimed invention of currently amended independent claim 5 calling for “notifying each of said set of intended recipients via an Internet enabled device or via facsimile of said saved facsimile and said specific storage location for retrieving said facsimile.” Therefore, independent claim 5 is not anticipated under 35 U.S.C. § 102. Accordingly, currently amended independent claim 5 is allowable.

Claims 6 through 13, 16, and 17 are allowable as depending from allowable currently amended independent claim 5. Claims 14 and 15 have been cancelled.

Regarding currently amended independent claim 18, such claim is directed to “[a] system for distributing facsimiles, comprising . . . a facsimile distribution center for receiving facsimiles, saving facsimiles, and sending notification messages to at least one Internet enabled device; a storage media for storing facsimiles saved by said facsimile distribution center; and a database for determining intended recipients for received facsimiles.”

Applicant asserts that Choksi does not expressly or inherently identically describe each and every element of currently amended independent claim 18 in as complete detail as contained in the claim to anticipate the claimed invention under 35 U.S.C. § 102. Applicant asserts that Choksi does not identically describe the element of the claimed invention of currently amended independent claim 18 calling for “sending notification messages to at least one Internet enabled device.” Applicant asserts that a few examples of Internet enabled devices are e-mail enabled printers, embedded web server printers, e-mail enabled print servers, and web browser enabled printers. Applicant asserts that there is no description anywhere in Choksi to an “Internet enabled device.” Therefore, Choksi does not anticipate currently amended independent claim 18 under 35 U.S.C. § 102. Accordingly, currently amended independent claim 18 is allowable.

Claims 19 and 20 are allowable as of depending from allowable currently amended independent claim 18.

Applicant submits that claims 1 through 13 and 16 through 20 are clearly allowable over the cited prior art.

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Applicant requests the allowance of claims 1 through 13 and 16 through 20 and the case passed for issue.

Respectfully submitted,



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